

Serial No. 09/941,450

PATENT

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RP

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Diane Kizer

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

CASE et al.

For: GENE IDENTIFICATION

Serial No.: 09/941,450

Filed: August 28, 2001

Atty. Docket No.: 8325-0007.20 (S7-US3)

) Examiner: J. Brusca

) Group Art Unit: 1631

) Confirmation No.: 6791

) **RESPONSE TO ELECTION OF**
) **SPECIES REQUIREMENT**

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Commissioner for Patents
Washington, D.C. 20231

Sir:

This paper is in response to the Election of Species Requirement mailed January 17, 2003 with a shortened statutory period of one-month for response. Accordingly, this response is timely filed.

The Examiner, in the Election Requirement, required election of one species in each of the following groups:

1st group: second molecule target of a bifunctional domain, from those recited in claims 15 and 17;

2nd group: phenotypes, from those recited in claims 23-25; and

3rd group: cell type, from those recited in claims 19-22.

Applicants elect, with traverse, estradiol from the first group; expression of an RNA molecule from the second group; and human cells from the third group.

Applicants traverse on the grounds that it would not unduly burdensome to search the allegedly distinct species together. For example, a search of the art for references relating to the


claimed methods in animal cells would necessarily reveal relevant art in plant, fungal and bacterial cells. Similarly, a search of the art for any change in phenotype would reveal art relevant to all of the allegedly distinct species of the 2nd group. Finally, a search of the art for estradiol's ability to activate the bifunctional domain in the methods set forth in claim 13 would necessarily reveal art relevant to all the other proteins and small molecules recited in claims 15 and 17. Since it would **not** be unduly burdensome to search all allegedly distinct species together (and indeed, would save the Office time and resources), Applicants request that the election of species requirement be withdrawn.

It is to be understood that these elections of species are for the purposes of preliminary search and examination only, and that upon allowance of a generic claim, applicants will be entitled to consideration of claims to the additional species.

Applicants expressly reserve their right under 35 USC §121 to file one or more divisional applications directed to any nonelected subject matter during the pendency of this application.

Respectfully submitted,

Date: 14 Feb 03

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